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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,332 11/06/98 NAYLOR

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EXAMINER

LMC1/0906

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ART UNIT

PAPER NUMBER

2758

DATE MAILED:

09/06/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/187332

Applicant(s)

N ALOR et al.

Examiner

Harrell

Group Art Unit

2758

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 11/6/98 et seq.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of References Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other office action

Office Action Summary

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1. Claims 1-18 are presented for examination.
2. Figures 1,3-5 should be labeled as "Prior Art" in light of Ho et al. (5,805,298) (see figure 2 of Ho and figure 1 of this application and see figure 1 of Ho and figures 3-5 of this application).
3. The serial number of the U.S. Application mentioned on page 11 must be updated along with its status (eg., still pending, or the corresponding U.S. Patent Number, or if abandoned).
4. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:
  - a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.
6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (5,805,298) alone or in view of Okada (6,101,244).
7. Ho taught the invention substantially as claimed, including a

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process for sending electronic mail or facsimiles (eg., see Abstract) from a facsimile machine (100 in figure 1 (eg., see figure 2, col. 3 (lines 27-32)) comprising the steps of:

- a) a user entering into the facsimile machine a facsimile telephone number (eg., see col. 6 (lines 31-35)) and an electronic mail address (eg., see col. 6 (lines 35-48)) corresponding to a same recipient;
- b) the user placing a document to be transmitted into a facsimile machine (eg., see figure 1 (101,204), col. 4 (lines 10-19));
- c) the fax machine storing the facsimile telephone number or electronic mail address in a memory location in a memory of the facsimile machine (eg., see col. 5 (line 40-et seq.));
- d) associating an actuator ("Send Button") disposed on the facsimile machine (eg., see figure 2(a)) to the memory location containing the facsimile telephone number and electronic mail address (eg., see figure 3 and col. 6 (line 23-et seq.)); and,
- e) the user activating the actuator to transmit a facsimile to the facsimile telephone number or electronic mail to the electronic mail address (eg., see col. 6 (lines 27-41) and col. 7 (lines 6-17)).

8. While Ho did not specifically send the message via both by

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facsimile and e-mail, such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 of Ho's abstract, in col. 1 (lines 46-53), and in col. 2 (lines 19-22) Ho suggested transmitting in both facsimile and electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view of Okada who taught that a scanned image could be sent by electronic mail and facsimile (eg., see Abstract (specifically lines 4-6)). Also, the claims of this application fails to teach at what moment (ie., at the same time) the electronic mail is transmitted with respect to the facsimile of the message (ie., a time lag is also covered by the claims). While Okada has a lag, the claims of this application does not provide any temporal relativity of when the facsimile and e-mail are sent, only that they are sent. None the less, sending the e-mail and facsimile at the same time would have been obvious to those skilled in the art.

9. It would have been obvious to have combined these references because they were both directed to sending electronic mail and

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facsimile to a recipient from a single device.

10. Per claim 2, Ho taught that his actuator was a button (eg., see figure 2(a)) and buttons are switches.

11. Per claims 3 and 4, Ho taught that electronic mail was sent via a server (SLIP/PPP (ie., an Internet Service Provider)) and facsimile was sent to the recipient via a PSTN 106 in figure 1 and col. 3 (lines 32-43).

12. Per claim 5, such is standard facsimile operations and was taught in Ho at col. 6 (line 27-et seq.)).

13. Per claim 6, while the device (100) performed these functions (ie., if there is a phone number the message was faxed or if it where an e-mail address the message was sent via e-mail) (eg., see col. 6 (lines 31-38) and col. 7 (lines 6-17)).

However, it would have been obvious to those skilled in the art to allow such functions to be performed by the server.

14. Per claim 7, while PSTN has been addressed, Ho taught of the use of the Internet (eg., see figure 1 (112)) which is a wide area network.

15. Per claims 8-18, these do not teach and define above the corresponding claims and are thus also rejected for the reasons outlined above.

16. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 9:30 am to 6:00 pm Eastern Standard Time.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar, can be reached on (703) 305-4731. The fax phone number for the Group is (703) 308-7201.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2758